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Robert D. Shedd, Patent Operations			EXAMINER	
THOMSON Licensing LLC			DASGUPTA, SOUMYA	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,649

**Applicant(s)**

GANDOLPH ET AL.

**Examiner**

SOUMYA DASGUPTA

**Art Unit**

2176

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 12-17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-17, and 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Applicant's Response***

In the applicant's response for application 10/584,649 dated October 22, 2009, the applicant amended claims 1-6, 12-17, and 20; cancelled claim 18; and added new claims 21-25; and argued against all the rejections and objections.

The rejections set forth under 35 USC 112 for 5 and 17 are withdrawn because the applicant amended the claims to clarify the subject matter.

Claims 1-7, 12-17, and 19-25 are currently pending and have been considered below.

Claims 1, 13, and 15 are independent claims.

***Claim Objections***

Claim 13 is objected to because of the following informalities:

- the last four limitations are confusingly worded because, based on the current format of the claim, it is unclear what element is performing the recited functions.

The examiner suggests the following amendment:

13. (currently amended) An apparatus for automatically generating an electronic menu including a plurality of menu pages, wherein each menu page contains selectable menu items with associated commands to be executed upon activation of the respective menu items, wherein the apparatus ~~comprising~~ comprises:

a menu controller for;

detecting a menu page number of a menu page currently displayed;  
[[for ]]retrieving<sub>x</sub> from at least two different storage media<sub>x</sub> menu related data and other data being selectable through the currently displayed menu page;  
[[for ]]determining<sub>x</sub> from a request for displaying another menu page<sub>x</sub> an allowed range of page numbers for the another menu page;  
[[for ]]detecting available menu pages having page numbers within said allowed range; and  
[[for ]]selecting said another menu page, wherein said another menu page is one of said available menu pages.

Applicant should note that there is one indentation before the phrase "a menu controller for:" (see Line 5) and there are two indentations before every subsequent phrase (see Lines 6-14).

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13 and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

*Claims 13 and 14:*

In summary, Claim 13 recites an “*apparatus*” that comprises a “*menu controller*” for performing various functions. Although the Specification of the present application fails to expressly indicate whether the recited “*menu controller*” is a computer hardware component or a computer software component, one of ordinary skill in the art would interpret it as being software. Likewise, for purposes of examination, the examiner will interpret the “*menu controller*” as a computer software element. Thus, the recited “*apparatus*” is software per se.

Accordingly, the “*apparatus*” is not a “process,” a “machine,” a “manufacture” or a “composition of matter,” and Claim 13 fails to recite statutory subject matter, as defined in 35 U.S.C. 101.

Claim 14 merely recites electronic data and additional functions performed by the software. Thus, Claim 14 does not further define the recited “*apparatus*” as being within a statutory process, machine, manufacture or composition of matter.

Accordingly, Claim 14 fails to recite statutory subject matter as defined in 35 U.S.C. 101.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

*Claims 1-5, 12-17, and 19-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al (US 2002/0041292; PG Pub Date: April 11, 2002; Patent Filing Date: Oct 2, 2001; Assignee: LG Electronics; hereafter Son) in view of Fender et al (US 2004/0012382; PG Pub Date: Jan 22, 2004; Patent Filing Date: Jul 17, 2002; Assignee: Agilent Technologies; hereafter Fender) in further view of Oetzel et al (US 2003/0227474; PG Pub Date: Dec 11, 2003; Patent Filing Date: April 3, 2003 Assignee: Sonic Solutions, Inc; hereafter Oetzel).*

**Claim 1:**

Son discloses:

**A method for automatically generating an electronic menu including a plurality of menu pages, wherein menu pages contain selectable menu items with associated commands to be executed upon activation of the respective menu item, the**

**method comprising:** (pre-amble) (Fig 5, Paragraph [0028] → The system shows a plurality of menus in which each of the menus has selectable commands.) **wherein associating a page number with each menu page;** (limitation 1) (Fig 5, Paragraph [0028] → Item P3 shows a numerals P3 that associate each menu. The root menu is the first number, the sub-menu has the second or subsequent numbers, and the last number is the current item being selected. Moreover, the examiner notes that "page numbers" are functionally equivalent to numerical P3 to other menus because the applicant is referring to *Fig 1, item 14 of the application* as the "page number" (Playlist #xxxx). The Playlist numbers refers to the current menu and points successive and previous menus pending on the user's selection.)

**a first menu page containing a first menu item with an associated command and said command associating with data, wherein the command associated with the first menu item comprises switching to another menu page;** (limitation 2) (Fig 5, Paragraph [0028] → The user can navigate between successive menus by selecting items from the previous menu.)

**and selecting a second menu page upon activation of said first menu item** (limitation 5) (Fig 5, Paragraph [0028] → The user can navigate between successive menus by selecting items from the previous menu.)

Son does not expressly disclose:

**determining a range of page numbers based upon said data associated with said command; (limitation 3) detecting available menu pages having page numbers within said range; (limitation 4)**

**and selecting a second menu page upon activation of said first menu item**  
**wherein the second menu page is one of available menu pages within the defined range of menu pages and wherein the first and second menu pages are retrieved from different storage media.** (limitation 5)

Fender discloses:

**determining a range of page numbers based upon said data associated with said command; (limitation 3) detecting available menu pages having page numbers within said range; (limitation 4)** (Paragraph [0066] – [0070] → Fender discloses these limitations in that the application control begins with the installation of a new application using the device's graphical user interface. The device's menu system is extended to incorporate at least one user interface entry for the new application. After the device's menu system has been extended, the new application may be launched using the device's extended menu system. Without an allocated range of memory or identifiers, the addition of alternate menus to an existing menu would not be possible.)



**and selecting a second menu page upon activation of said first menu item**  
**wherein the second menu page is one of available menu pages within the defined**  
**range of menu pages** (Paragraph [0066] – [0070] →(Paragraph [0066] – [0070] →

Fender discloses these limitations in that the application control begins with the installation of a new application using the device's graphical user interface. The device's menu system is extended to incorporate at least one user interface entry for the new application. After the device's menu system has been extended, the new application may be launched using the device's extended menu system. Without an allocated range of memory or identifiers, the addition of alternate menus to an existing menu would not be possible.)

for the purpose of "extending the functionality of the [device] through the new application while retaining the operational feel of an integrated solution" (see Paragraph [0009]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Son to include:

**determining a range of page numbers based upon said data associated**  
**with said command; (limitation 3) detecting available menu pages having**  
**page numbers within said range; (limitation 4)**

**and selecting a second menu page upon activation of said first menu item  
wherein the second menu page is one of available menu pages within the  
defined range of menu pages.** (limitation 5)

for the purpose of extending the functionality of the [device] through the new application while retaining the operational feel of an integrated solution, as taught by Fender.

Sun in view of Fender do not expressly disclose:

**and selecting a second menu page upon activation of said first menu item  
wherein the second menu page is one of available menu pages within the defined  
range of menu pages and wherein the first and second menu pages are retrieved  
from different storage media.** (limitation 5)

Oetzel discloses:

**and selecting a second menu page upon activation of said first menu item  
wherein the second menu page is one of available menu pages within the defined  
range of menu pages and wherein the first and second menu pages are retrieved  
from different storage media.** (limitation 5) (Paragraph [0042] → The initial menu is stored on a DVD (first media) and then transferred to a hard drive (second media). Afterwards, additional menu items are transferred to the initial menu.)

for the purpose of "[determining] the minimum amount of file rewriting required to effect the desired revisions to the project" (see Paragraph [0017]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Son in view of Fender to include:

**and selecting a second menu page upon activation of said first menu item wherein the second menu page is one of available menu pages within the defined range of menu pages and wherein the first and second menu pages are retrieved from different storage media.** (limitation 5)

for the purpose of determining the minimum amount of file rewriting required to effect the desired revisions to the project, as taught by Oetzel.

**Claim 2:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son discloses:

**wherein determining said range of page numbers is also based upon a page numbers of said first menu page.** (Fig 5, Paragraph [0028] → Item P3 shows a numerals P3 that associate each menu. The root menu is the first number, the sub-

menu has the second or subsequent numbers, and the last number is the current item being selected. Hence, the second menu number is based on the first menu number.)

**Claim 3:**

Son, Fender, and Oetzel disclose the limitations of Claim 2.

Son discloses:

**wherein determining said range is further based on a page number of another menu page that is stored on the same storage medium as the first menu page.**

(Fig 1. In this system, the menus are stored on the cell phone.)

**Claim 4:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son discloses:

**wherein determining said range is based on a placeholder within said data**

**associated with said command.** (Fig 5, Paragraph [0028] → Here, the placeholders are functionally equivalent to successive numbers. The placeholder for the root menu is the first number, the placeholder for the sub-menu is the second number, and so on.)

**Claim 5:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son discloses:

**wherein said data associated with said contain a numeric value** (Fig 5, Paragraph [0028] → The identifier associated with the menus are numerical) **and wherein determining the range of page numbers is based defined by the numeric value and the page number of said first menu page, (** (Fig 5, Paragraph [0028] → Here, the placeholders are functionally equivalent to successive numbers. The placeholder for the root menu is the first number, the placeholder for the sub-menu is the second number, and so on. Hence, the range extends with respect to the root menu.)

**and wherein the second menu page is one of said available menu pages having page numbers greater the page number of said first menu page if the numeric value is positive.** ((Fig 5, Paragraph [0028] → Here, the first place holder in the root menu has a positive value, which is 1. Any subsequent pages place holders in the root menu will be greater than 1. The sub-menu with will be 1-1, 1-2, and so forth. Hence, the sub-menu's reference is greater than the root menus reference. The examiner notes that 1-1 is greater than 1.)

**Claim 12:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son in view of Fender do not expressly disclose:

**wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available. ()**

Oetzel discloses:

Son in view of Fender do not expressly disclose:

**wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available.** (Paragraph[006] → The user can navigate the menus to play AV files on a DVD)

for the purpose of "[determining] the minimum amount of file rewriting required to effect the desired revisions to the project" (see Paragraph [0017]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Son in view of Fender to include:

**wherein detecting of the page numbers of the available menu pages includes detecting if the corresponding AV content selectable from said menu page is also available.**

for the purpose of determining the minimum amount of file rewriting required to effect the desired revisions to the project, as taught by Oetzel.

**Claim 13:**

Claim 13 corresponds to Claim 1.

**Claim 14:**

Claim 14 corresponds to Claim 5.

**Claim 15:**

Claim 15 corresponds to Claim 1.

**Claim 16:**

Claim 16 corresponds to Claim 4.

**Claim 17:**

Claim 17 corresponds to Claim 5.

**Claim 19:**

Claim 19 corresponds to Claim 7.

**Claim 20:**

Claim 20 corresponds to Claim 12.

**Claim 21:**

Claim 21 corresponds to Claim 4.

**Claim 22:**

Claim 22 corresponds to Claim 5.

**Claim 23:**

Claim 23 corresponds to Claim 6.

**Claim 24:**

Claim 24 corresponds to Claim 7.

**Claim 25:**

Claim 25 corresponds to Claim 5.

*Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al (US 2002/0041292; PG Pub Date: April 11, 2002; Patent Filing Date: Oct 2, 2001; Assignee: LG Electronics; hereafter Son) in view of Fender et al (US 2004/0012382; PG Pub*



*Date: Jan 22, 2004; Patent Filing Date: Jul 17, 2002; Assignee: Agilent Technologies; hereafter Fender) in further view of Oetzel et al (US 2003/0227474; PG Pub Date: Dec 11, 2003; Patent Filing Date: April 3, 2003 Assignee: Sonic Solutions, Inc; hereafter Oetzel) in further view of Herle et al(US 2002/0101459; PG Pub Date: August 1, 2002; Patent Filing Date: December 28, 2001; Assignee: Samsung Electronics; hereafter Herle)*

**Claim 6:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son in view of Fender in further view of Oetzel do not expressly disclose:

**wherein one of said menu pages is stored in a file, or in a selectable portion of the file, and a page number of said one of said menu pages is determined by a name of the file, or by the name of the file and the selectable portion within the file, in which it is stored.**

Herle discloses:

**wherein one of said menu pages is stored in a file, or in a selectable portion of the file, and a page number of said one of said menu pages is determined by a name of the file, or by the name of the file and the selectable portion within the**

**file, in which it is stored.** (Paragraph [0040] →Menu options file stores a default list of menu options which have been enabled or disabled by the manufacturer.)

for the purpose of "ensuring integrity of GUI parameter data used by a data driven user interface" (see Paragraph [0010]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Son in view of Fender in further view of Oetzel to include:

**wherein one of said menu pages is stored in a file, or in a selectable portion of the file, and a page number of said one of said menu pages is determined by a name of the file, or by the name of the file and the selectable portion within the file, in which it is stored.**

for the purpose of ensuring integrity of GUI parameter data used by a data driven user interface, as taught by Herle.

*Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Son et al (US 2002/0041292; PG Pub Date: April 11, 2002; Patent Filing Date: Oct 2, 2001; Assignee: LG Electronics; hereafter Son) in view of Fender et al (US 2004/0012382; PG Pub*

*Date: Jan 22, 2004; Patent Filing Date: Jul 17, 2002; Assignee: Agilent Technologies; hereafter Fender) in further view of Oetzel et al (US 2003/0227474; PG Pub Date: Dec 11, 2003; Patent Filing Date: April 3, 2003 Assignee: Sonic Solutions, Inc; hereafter Oetzel) in further view of Escobar et al (US 5,659,793; Assignee: Bell Atlantic Video Services;; hereafter Escobar).*

**Claim 7:**

Son, Fender, and Oetzel disclose the limitations of Claim 1.

Son in view of Fender in further view of Oetzel do not expressly disclose:

**the page number associated with the first or second menu page depends on user specific settings. ()**

Excober discloses:

**the page number associated with the first or second menu page depends on user specific settings.** (The user can create his own custom menus to facilitate program selection. In other words, when the menus change, the page numbers associated with the menus change. Hence, the user is altering the page number by changing the menu arrangement.)

for the purpose of providing a "reduction of the time and complexities required to refresh or customize interactive multimedia applications" (Col 3, Lines 25-274).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system, disclosed in Son in view of Fender in further view of Oetzel to include:

**wherein one of said menu pages is stored in a file, or in a selectable portion of the file, and a page number of said one of said menu pages is determined by a name of the file, or by the name of the file and the selectable portion within the file, in which it is stored.**

for the purpose of providing a reduction of the time and complexities required to refresh or customize interactive multimedia applications, as taught by Escobar.

### ***Response to Arguments***

#### Claims (1-7,12-17, and 19-25) Rejection under 35 USC ~ 102(b):

The applicant argues that the prior art does not disclose the limitations of Claims 1, 13, and 15 and their respective dependent claims. The applicant also states that the 35

USC 102(b) rejection is invalid because the examiner used 2 references. Applicant's arguments, see pages 7-11, filed April 14, 2010, with respect to the rejection(s) of claim(s) 1-7 and 12-20 under 35 USC 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Son in view of Fender in further view of Oetzel.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SOUMYA DASGUPTA whose telephone number is (571)272-7432. The examiner can normally be reached on M-Th 9am-7pm, F 9am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SD

/DOUG HUTTON/  
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